

REMARKS/ARGUMENTS

In response to the Examiner's rejections, the claims have been amended as specified above. None of the amendments adds new matter.

More particularly, claims 1, 11, and 20 have been amended to include the limitation that the accounts with which the graphic user interface or application software, as appropriate, are linked are accounts from which an account holder "may withdraw cash or other legal tender." In other words, an account linked to the GUI or software of this invention is a real financial account containing real money from which the account holder is able to withdraw real money that may be spent and used anywhere, as opposed to an account that is merely a collection of points or credits that the account holder may exchange for select merchandise or other awards at a limited number of locations such as partner stores or sponsor websites. These amendments add no new matter.

Claim 1 has also been amended to include the limitation that the method is a method for teaching financial management skills "to children." This amendment adds no new matter.

Claim 2 has been amended to correctly indicate that it depends on claim 1.

Claim Rejections – 35 U.S.C. § 102

"An applicant for a patent is entitled to the patent unless the application fails to meet the requirements established by law. It is the Commissioner's duty (acting through the examining officials) to determine that all requirements of the Patent Act are met. The burden is on the Commissioner to establish that the applicant is not entitled under the law to a patent In rejecting an application, factual determinations by the PTO must be based on a preponderance of the evidence, and legal conclusions must be correct." *In re Oetiker*, 977 F.2d 1443, 1449, 24 USPQ2d 1443, 1447, 24 USPQ2d at 1447 (Fed. Cir. 1992) (Plager, J., concurring). Further, "[t]he precise language of 35 USC 102 that 'a person shall be entitled to a patent unless,' concerning novelty and unobviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103." *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173 (CCPA 1967), *cert. denied*, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968).

Claims 1–8

The Examiner rejected claims 1 through 8 under 35 U.S.C. § 102(b) as being anticipated by the e-critter game for teaching personal values and financial responsibility to a child described in U.S. Patent Number 6,729,884 (the Kelton patent).

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 828 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). MPEP § 2131.

Claim 1 has been amended to specify that the graphic user interface has at least one educational game operatively linked to a stored value financial transaction account “from which a holder of the stored value financial transaction account may withdraw cash or other legal tender.” Because claims 2 through 8 depend on claim 1, claims 2 through 8 include this limitation.

Kelton describes an internet-based game for teaching personal values and financial responsibility to a child. It includes “interactive game events, an adventure story with selectable story elements, a scoring system awarding a virtual collectible creature having artificial intelligence characteristics and characteristics mimicking a financial instrument, and indicia of account information.” (Abstract). By successfully completing games, the child earns points or “Critttercash Points.” (Col. 17: 15–20). The child may redeem the points or “Critttercash” to purchase merchandise or get discounts from one or more participating partners or sponsors. (Col. 9: 22–27; Col. 11: 22–24; Col. 14: 57–59; Col. 20: 40–44, 50–52, 55–67 — Col. 21:1–4, 48–49; Col. 22: 5–9; Col. 24: 9–25, 38–43; Col. 25: 22–25, 36–40; Col. 26: 36–43, 54–59; Col. 27: 52–59; Col. 28: 26–33, 45–48; Col. 29: 61–67; Col. 31: 16–19, 28–34; Col. 32: 33–36). Thus, while the game in Kelton allows the child to make withdrawals, the withdrawals are only of points or Critttercash and can be used only “in obtaining merchandise from a partner . . . and/or sponsor” (Col. 23: 34–36). The retailers that are partners or sponsors select “the discounts and/or merchandise in accord with a marketing agenda established by the retailer.” (Col. 25: 25–27; Col. 28: 26–33). Accordingly, the child is limited as to what he or she can purchase with the points or Critttercash he or she earned using the e-critter game.

The method for teaching financial management skills to children of claim 1, as amended, on the other hand, links the at least one educational game to a stored value financial transaction account from which a holder of the stored value financial transaction account may withdraw cash or other legal tender. Specifically, the money acquired while using the game of claim 1 represents real money held in an account at a real financial institute. Thus, the account holder may withdraw real money, i.e., cash or legal tender, and spend it anywhere cash or legal tender is accepted.

Because the child using the e-critter game of Kelton is limited to redeeming points or Critttercash only for merchandise or discounts and only as offered by select partners or sponsors,

Kelton does teach the element of claim 1, as amended, of involving a “stored value financial transaction account from which a holder of the stored value financial transaction account may withdraw cash or other legal tender.” Accordingly, each and every element of claim 1, as amended, and therefore of claims 2 through 8, is not found in Kelton. Thus, Applicant respectfully contends that Kelton does not anticipate claims 1 through 8.

Claims 11–18

The Examiner rejected claims 11 through 18 under 35 U.S.C. § 102(b) as being anticipated by Kelton.

Claim 11 has been amended to specify that the graphic user interface has at least one game linked to a financial account “from which a holder of the financial account may withdraw cash or other legal tender.” Because claims 12 through 18 depend on claim 11, claims 12 through 18 include this limitation.

As discussed above, Kelton involves a game in which the child playing the game earns points or “Critttercash Points.” The child may redeem his or her points or Critttercash only with select partners or sponsors and only for such discounts or merchandise as the partner or sponsor chooses to make available. Accordingly, Kelton does not teach the element of claim 11, as amended, of involving a “financial account from which a holder of the financial account may withdraw cash or other legal tender.” Thus, each and every element of claim 11, and therefore of claims 12 through 18, is not found in Kelton. Hence, Applicant respectfully contends that Kelton does not anticipate claims 11 through 18.

Claim Rejections - 35 U.S.C. § 103

Claims 9 and 10

The Examiner rejected claims 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable (obvious) over Kelton in view of the education and life skills organizer/memory aid described in U.S. Patent No. 5,890,905 (the Bergman patent). The Examiner contends that modifying the e-critter game of Kelton so as to include features taught by Bergman would result in the present invention, with each and every element thereof.

Section 706.02(j) of the MPEP sets forth the requirements for establishing the *prima facie* case of obviousness as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In this case, first, there is no suggestion or motivation to modify Kelton to include the features of Bergman or to combine Kelton and Bergman. Second, there is no reasonable expectation of achieving success in combining Kelton and Bergman. Third, Kelton and Bergman, when combined, do not teach or suggest all the claim limitations of claims 9 and 10, particularly in light of the amendment to claim 1.

There is no suggestion or motivation to modify Kelton to include the features or Bergman or to combine Kelton and Bergman.

The law regarding obviousness is clear: any modification of the prior art must be suggested or motivated by the prior art.

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.” [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious “modification” of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fitch, 972 F.2d 1260, 23 USPQ2d 1780, 1783–84 (Fed. Cir. 1992) (quoting, in part, *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). Further, even if the prior art may be modified as suggested by the Examiner, the modification is not obvious unless the prior art suggest the *desirability* for the modification. *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992) (noting that the “mere fact that prior art may be modified to reflect features of claimed invention does not make the modification, and hence, the claimed invention, obvious unless the desirability of such a modification is suggested by prior art”) (citing *In re Gordon*, 733 F.2d at 902, 221 USPQ at 1127). Moreover, the motivating suggestion must also be explicit. An invention cannot be found obvious unless there is “some explicit teaching or suggestion in art to motivate one of even ordinary skill to combine such

elements so as to create the same invention.” *Winner Int’l Royalty Corp. v. Wang*, 48 USPQ2d 1139, 1140 (D.C.D.C. 1998).

Because Kelton and Bergman have significantly different goals, it would not be desirable to modify Kelton to include features of Bergman, and there is no suggestion or motivation, explicit or otherwise, to combine the two references or to modify Kelton to include features of Bergman. The goal of Kelton is to teach children personal values and financial responsibility through fun activity that challenges the child. In other words, the child must jump through some hoops to receive an award. The goal of Bergman, on the other hand, is to provide cognitively-impaired people with an *easy* and fun way of learning and organizing tasks. The Money Manager, takes the user through a step-by-step process for recording funds entered and withdrawn from savings and checking accounts and for writing checks on checking accounts. (Col. 9: 26–28). Accordingly, while Kelton is designed to challenge the user by testing the user’s abilities and knowledge, only rewarding the user when the ability and knowledge level is demonstrably high, Bergman is designed to eliminate challenges for the user such that the user need not demonstrate significant ability or knowledge of financial matters. Thus, there is no suggestion or motivation to modify a method designed to challenge a user with features of a method designed to make things easier for the user or to combine such methods.

There is no reasonable expectation of achieving success in combining Kelton and Bergman.

“Both the suggestion and the expectation of success must be founded in the prior art, not in applicant’s disclosure.” *In re Dow Chemical Co. v. Am. Cyanamid Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988). “Obvious to try or to experiment is not sufficient.” *Yamanouchi Pharm. Co. v. Marsam Pharm., Inc.*, 231 F.3d 1339, 56 USPQ2d 1641 (Fed. Cir. 2000).

In this case, because Kelton and Bergman have such different goals, as discussed above, there is no reasonable expectation of achieving success in combining them. That is, because Bergman is designed to make using its method as easy as possible for the user, without requiring the user to remember complicated steps, etc., one combining its features with those of Kelton would not reasonably expect to achieve the success sought by Kelton, i.e., the success of challenging a user and testing a user’s knowledge of financial matters. After all, Bergman is meant to be used by cognitively-impaired people and is designed so that the user does not have to remember very much to use the method while Kelton is meant to be used by children and is designed to test, in part, how much the child can remember.

Kelton and Bergman, when combined, do not teach or suggest all the claim limitations of claims 9 and 10.

Claims 9 and 10 depend on claim 1. Claim 1 has been amended to specify that the graphic user interface has at least one educational game operatively linked to a stored value financial transaction account “from which a holder of the stored value financial transaction account may withdraw cash or other legal tender.” Because claims 9 and 10 depend on claim 1, claims 9 and 10 include this limitation.

As discussed above, the game of Kelton is not linked to an account from which cash or other legal tender may be withdrawn. Further, Kelton does not teach or suggest such a limitation. To the contrary, Kelton teaches away from having the game involve real money (aside from using real money to buy into the game). (See Col. 5: 55–58 (“It is an object of the present invention to provide the game of the present invention to be used by a teacher to teach a younger child personal values and financial responsibility, *where the risk of losing real dollars is removed.*”) (emphasis added)).

Likewise, Bergman does not teach or suggest the limitation of linking to an account from which cash or other legal tender may be withdrawn. To the contrary, the money manager module of Bergman is essentially merely a record-keeping tool that is not linked to any account. (See Col. 9: 26–28 (“The Money Manager module 224 (FIGS. 101–131) provides the user with the ability to record funds entered and withdrawn from savings and checking accounts.”)). Because the Bergman device is not linked to an account, when automatic deposits are made to the user’s account, the user must contact his or her bank, presumably via phone, to confirm that the automatic deposit was indeed made before the deposit amount will be entered into the ledger. (Col. 12: 63–67 — Col. 13: 1–11 (“On the designated date the user receives a message indicating an Automatic Deposition should have occurred. Upon attempting any checking transaction, the first screen indicates that a deposit has occurred and prompts the user to contact his bank, with the name and phone number of the bank contact person. When the deposit is confirmed, the user points/clicks the ‘Yes’ subfunction button and the deposit is entered into the Checking Ledger (FIG. 27).”). Were the Money Manager actually linked to the account, no verification of deposit by phone would be necessary.

Because neither Kelton nor Bergman include the limitation of having a game “operatively linked to a stored value financial transaction account from which a holder of the stored value financial transaction account may withdraw cash or other legal tender,” Kelton and Bergman, when combined, do not teach or suggest all the claim limitations of claims 9 and 10, in light of the amendments to claim 1.

For the foregoing reasons, Applicant respectfully contends that claims 9 and 10 are not obvious over Kelton in view of Bergman.

Claim 19

The Examiner rejected claim 19 under 35 U.S.C. § 103(a) as being unpatentable (obvious) over Kelton in view of Bergman. The Examiner contends that modifying the e-critter game of Kelton so as to include features taught by Bergman would result in the present invention, with each and every element thereof. However, in light of the amendment to claim 11, for the same reasons claims 9 and 10, in light of the amendments to claim 11, are not obvious over Kelton in view of Bergman, claim 19 is not obvious over Kelton in view of Bergman.

Similar to the amendment to claim 1, the amendment to claim 11 specifies that the financial account with which the at least one game is linked is an account “from which a holder of the financial account may withdraw cash or other legal tender.” Claim 19 depends on claim 14, which depends on claim 11. Therefore, claim 19 depends on claim 11 and includes this limitation.

As discussed above, (1) there is no suggestion or motivation to modify Kelton to include features of Bergman or to combine Kelton and Bergman; (2) there is no reasonable expectation of achieving success in combining Kelton and Bergman; and (3) Kelton and Bergman, when combined, do not teach or suggest the limitation of a game linked to an account “from which a holder of the financial account may withdraw cash or other legal tender.” Accordingly, as with claims 9 and 10, in light of the amendments to claim 11, Applicant respectfully contends that claim 19 is not obvious over Kelton in view of Bergman.

Claim 20

The Examiner rejected claim 20 under 35 U.S.C. § 103(a) as being unpatentable (obvious) over Kelton in view of Bergman. The Examiner contends that modifying the e-critter game of Kelton so as to include features taught by Bergman would result in the present invention, with each and every element thereof. However, in light of the amendments to claim 20, for the same reasons claims 9, 10, and 19 are not obvious over Kelton in view of Bergman, claim 20 is not obvious over Kelton in view of Bergman.

Similar to the amendments to claims 1 and 11, the amendments to claim 20 specify that the account with which the application software is linked is an account with a financial institution “wherein a holder of said account may withdraw cash or other legal tender.”

As discussed above, (1) there is no suggestion or motivation to modify Kelton to include features of Bergman or to combine Kelton and Bergman; (2) there is no reasonable expectation of achieving success in combining Kelton and Bergman; and (3) Kelton and Bergman, when combined, do not teach or suggest the limitation of applicant software linked to an account with a financial institution "wherein a holder of said account may withdraw cash or other legal tender." Accordingly, as with claims 9, 10, and 19, Applicant respectfully contends that claim 20, as amended, is not obvious over Kelton in view of Bergman.

Conclusion

If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below.

Reconsideration and allowance of the application as amended is respectfully requested.

DATED this 26th day of February, 2007.

Very respectfully,



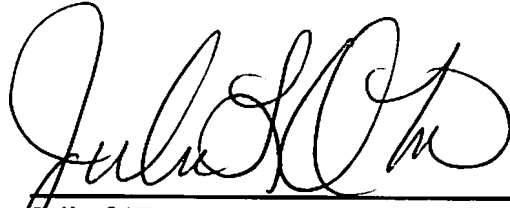
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